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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,607	07/26/2001	Rodney D. Cambridge	NETAP014	8717
28875	7590	01/04/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			SCHUBERT, KEVIN R	
			ART UNIT	PAPER NUMBER
			2137	
DATE MAILED: 01/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,607

Applicant(s)

CAMBRIDGE, RODNEY D.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01042002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-33 have been considered.

Claim Objections

5 Claim 18 is objected to. The claim makes little sense as stated. Logical expressions generally take the form when "a", then "b". Claim 18 is in the form when "a", then "a". The examiner assumes that the phrase "it is determined that the first Bluetooth transmission signal is not received from the second Bluetooth-enabled device" should be replaced with "it is determined that the first Bluetooth device is outside of the predefined range of the second Bluetooth-enabled device". Appropriate correction or
10 clarification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

15 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

 Claims 1,3,4,31, and 32 are rejected under 35 USC 112, second paragraph. The term "substantially" is a relative term which renders the claims indefinite. The term "substantially" is not
20 defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for
25 the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

30 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5 Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Odagari, U.S. Patent Application Publication No. 2001/0007817.

As per claims 1 and 29, the applicant describes a handheld security system with the following limitations which are met by Odagari:

- 10 a) a Bluetooth-enabled control unit having a range of communications ([0009], [0043]);
- b) a Bluetooth-enabled device, wherein the device is registered with the control unit such that the device cooperates with the control unit using Bluetooth communications to determine when the device is within the range of communications of the control unit, wherein when it is determined that the device is within the range of communications of the control unit, the device is functional, and when it is determined
- 15 that the device is not within the range of communications of the control unit, the device is substantially non-functional ([0009], [0043], [0085]).

As one can see from the paragraphs referenced above, the primary reference discloses a control unit, which is preferably wearable (like a wristwatch) and a device (mobile phone, pda, etc) which communicate with each other to make sure that the device has not gone outside a predetermined range

20 and is therefore not lost or stolen. The applicant should note that the first "information processor" of paragraph [0009] is the device and the "information processor previously assigned" is the control unit which the device has registered with for the purpose of the communication. The communication between the control unit and the device is Bluetooth [0043] in the preferred embodiment.

The applicant should also note that when it is determined that the device is out of range, "it can

25 be set so that an unauthorized person cannot operate it without the possessor's (user's) permission" [0085]. The device can therefore be made to be non-functional or locked out when it is out of a predetermined range.

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Regarding claim 29, the applicant discloses a claim identical to claim 1 with the exception that WiFi communication is used instead of Bluetooth communication. As noted in paragraph [0043], Bluetooth is just an example of wireless communication that can be used. The system of the primary reference is applicable to other wireless forms of communication, including WiFi.

5

As per claims 2, 11, 12, 21, 22, and 30, the applicant limits the handheld security system of claims 1, 10, 11, 20, 21, and 29 respectively, which are met by Odagari (see above), with the following limitation which is also met by Odagari:

Wherein the device is configured to periodically send an identifying signal to the control unit and the control unit is configured to send a return signal to the device when the identifying signal is received by the control unit ([0019]).

Regarding claims 12 and 22, the nature of the device/wristwatch system is for the information processor (mobile phone) to automatically send an identification signal of the device to the information processor previously assigned (wristwatch) every predetermined increment of time to make sure the device is still in the vicinity of the wristwatch.

As per claims 3 and 31, the applicant limits the handheld security system of claims 2 and 20 respectively, which are met by Odagari (see above), with the following limitation which is also met by Odagari:

Wherein the device includes a lockout interface, wherein when the device does not receive the return signal in response to the identifying signal, the device is not within the range of communications of the control unit and the lockout interface locks out the device and causes the device to be substantially non-functional ([0069] and [0070]);

If no reply signal is recognized and a setting is set, the information processor or device puts itself in such a state as to be unresponsive to operation commands.

25

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As per claims 4,5,32, and 33, the applicant limits the handheld security system according to claims 3,4,31, and 32, which are met by Odagiri (see above), with the following limitation which is also met by Odagiri:

5 Wherein when the device is substantially non-functional, the device is configured to continue periodically sending the identifying signal to the control unit ([0087] and [0088]);

The preferred embodiment of the primary reference discloses a system where the mobile device is shut down in response to not receiving a reply signal from the control unit. This is accomplished in part through the use of a changeover section (306 in Figure 3 and 406 in Figure 4) which changes the transmitting means between the mode of transmitting to the control unit to the mode of not transmitting.

10 In one circumstance as described in paragraphs [0087] and [0088], the user might want to only have the phone alert him when a signal is received rather than have the phone continuously send an alert signal which could be audible and therefore annoying to others close by. Therefore, the primary reference discloses in one embodiment that "even if the distance to the wristwatch type information processor is equal to or larger than the predetermined distance, it is possible to inhibit the predetermined
15 command" ([0088]) of making the phone always go in transmission shut down mode. Furthermore, since the phone can be set so that it is still active in transmitting and receiving signals once lockout has occurred, the limitations of claims 4 and 32 are met.

Regarding claims 5 and 33, if the transmission mode is not inhibited anymore, the device (mobile phone) works normally as if the changeover section did not exist.

20

As per claim 6, the applicant limits the handheld security system of claim 1, which is met by Odagari (see above), with the following limitation which is also met by Odagari:

Wherein the device is exclusively registered with the control unit ([0009]);

25 According to the paragraph referenced above the control unit, or wristwatch, is labeled the "information processor previously assigned" ([0009]). In other words, the mobile device is registered with the wristwatch. Since the invention takes place between one device and one wristwatch which it is registered to, the device is exclusively registered with the wristwatch, or control unit.

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As per claim 7, the applicant limits the handheld security system of claim 1, which is met by Odagari (see above), with the following limitation which is also met by Odagari:

Wherein the control unit is configured to produce an alert when it is determined that the device is
5 not within the range of communications of the control unit ([0013 (last four lines)]).

As per claims 8,9, and 28, the applicant limits the handheld security system of claims 7,1, and 26 respectively, which are anticipated by Odagari (see above), with the following limitation which is also met by Odagari:

10 Wherein the control unit includes a display, the display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit ([0063]);

The applicant should note the display section (207) of Figure 2.

Regarding claim 9, the applicant should note that paragraph [0063] discusses that the same
15 method of display for the control unit can be applied to the device.

Regarding claim 28, the use of a computing environment is discussed in paragraph [0092] and in the rejection for claim 26 (see above).

As per claim 10, the applicant describes a method for executing a security protocol for a first
20 Bluetooth-enabled device with respect to a second Bluetooth-enabled device comprising the following limitations which are met by Odagari:

a) emitting a first Bluetooth transmission signal from the first Bluetooth-enabled device ([0066]);

b) determining if a second Bluetooth transmission signal is received from the second Bluetooth-enabled device ([0067]);

25 c) locking out the first Bluetooth-enabled device to substantially prevent the first Bluetooth-enabled device from functioning if it is determined that the second Bluetooth transmission signal is not received ([0068] and [0069]);

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Bluetooth communication is mentioned as the preferred embodiment ([0043]).

As per claims 13 and 23, the applicant describes the method of claims 10 and 20, which are anticipated by Odagiri (see above), with the following limitation:

5 a) determining when a predetermined period of time has elapsed after locking out the first Bluetooth-enabled device ([0019]);

 b) emitting the first Bluetooth transmission signal from the first Bluetooth-enabled device if it is determined that the predetermined period of time has elapsed after locking out the first Bluetooth-enabled device ([0019]);

10 c) determining when the second Bluetooth transmission signal is received from the second Bluetooth-enabled device in response to the first Bluetooth transmission signal emitted when it is determined that the predetermined period of time has elapsed after locking out the first Bluetooth-enabled device ([0019]);

 d) reversing the lock out of the first Bluetooth-enabled device to allow the first Bluetooth-enabled
15 device to function when it is determined that the second Bluetooth transmission signal is received ([0087] and [0088]);

As described above in the rejection for claims 4,5,32, and 33, one embodiment of the primary reference discloses that during lock out the information processor (mobile device) can still be in active transmission mode. In this case, parts a), b), and c) are rejected because the information processor is
20 running normally and when it runs normally it performs the limitations of parts a), b), and c). Regarding part d), if the transmission mode is not inhibited anymore, the device (mobile phone) works normally as if the changeover section did not exist and the transmission was never in off mode. If a reply signal is heard, the system will be functional again.

25 As per claim 14 and 24, the applicant describes the method of claim 10, which is anticipated by Odagiri (see above), with the following limitation which is also anticipated by Odagiri:

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Displaying information on a screen of the first Bluetooth-enabled device which indicates that the first Bluetooth-enabled device is locked out ([0074] and [0075]).

As per claim 15, the applicant limits the method of claim 10, which is anticipated by Odagari (see above), with the following limitation which is also met by Odagari:

Operating the first Bluetooth-enabled device if it is determined that the second Bluetooth transmission signal is received ([0067] and [0068]).

As per claims 16 and 26, the applicant discloses a method for executing a security protocol comprising the following limitations which are met by Odagari:

a) determining when a first Bluetooth transmission signal is received from the second Bluetooth-enabled device ([0013]);

b) emitting a second Bluetooth transmission signal when it is determined that the first Bluetooth transmission signal is received from the second Bluetooth-enabled device ([0013]);

c) generating an alarm to indicate that the second Bluetooth-enabled device is not within a communications range of the first Bluetooth-enabled device when it is determined that the first Bluetooth transmission signal is not received from the second Bluetooth-enabled device ([0013] and [0063]);

The first Bluetooth enabled device corresponds to the information processor (mobile phone) and the second Bluetooth enabled device corresponds to the other information processor previously assigned (wristwatch). Figures 3 and 4 provide a good illustration of the communication. The applicant should also note that the use of Bluetooth communication is mentioned as the preferred communication between the devices ([0043]).

Regarding part a), the information processor (mobile phone) has "decision means for making a determination as to whether the reply signal has been received" ([0013]).

Regarding part b), the information processor (mobile phone) has "transmitting means for transmitting a signal...when a signal is received" ([0013]).

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Regarding part c), the information processor (mobile phone) has "alert means for performing alerting with respect to the reception of the signal by the first receiving means depending upon the result of the determination made by the decision-means" ([0013]). Alerting means, as defined later in Odagiri, comprise "a method of outputting a predetermined signal, sound, speech or the like through the speaker" ([0063]). This encompasses an alarm.

Regarding claim 26, the claim discloses all the limitations of claim 16 with the additional limitation of the system taking place in a computing environment. Odagiri discloses that the system can take place in a computing environment with computers as the information processors. If computers were used, computer codes, processors, and a computer-readable medium that stores computer codes would be used, so all the limitations are met.

As per claims 17, 18, and 27, the applicant limits the method of claims 16, 17, and 26 respectively, which are anticipated by Odagiri, with the following limitations which are also anticipated by Odagiri:

a) determining when a predetermined period of time has elapsed [0067];

b) determining whether the first Bluetooth transmission signal is received from the second Bluetooth-enabled device when the predetermined period of time has elapsed [0067 and 0068];

The first Bluetooth-enabled device (mobile phone) transmits a signal to a second Bluetooth-enabled device (wristwatch) and then waits a predetermined time for the signal to be sent back [0067].

Regarding claim 18, if the signal is not received in that predetermined time, it is then determined that the device is outside the communicable range and either an error message or a lockout operation is engaged [0068 and 69].

The use of a computing environment is discussed in paragraph [0092] and in the rejection for claim 26 (see above).

As per claim 19, the applicant limits the method of claim 16, which is anticipated by Odagiri (see above), with the following limitation which is also anticipated by Odagiri:

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Determining when the second Bluetooth-enabled device is registered with the first Bluetooth-enabled device, wherein emitting the second Bluetooth transmission signal when it is determined that the first Bluetooth transmission signal is received from the second Bluetooth-enabled device includes emitting the second Bluetooth transmission signal when it is determined that the second Bluetooth-enabled device
5 is registered with the first Bluetooth-enabled device [0009];

The second information processor (wristwatch) has been "previously assigned" [0009], and the transmitter and receiver will only transmit or receive from the "previously assigned" information processor as explained in the primary reference. Thus, though Odagiri does not go into much detail, there is a determination step associated with the transmission and the receiving of the information processor
10 (mobile phone) and the information processor previously assigned (wristwatch) which makes sure they are compatible.

As per claim 20, the applicant discloses a first device which has the limitations of claim 10 which has been discussed already with the additional limitation of the system being in a computing environment.
15 As described by Odagiri, "the information processing method described with respect to the embodiment of the present invention can be practiced by executing a prepared program in a computer such as a personal computer or a workstation" ([0092]). Since the method can take place through a computer or in a computing environment, the use of computer codes, a processor, and a computer-readable medium are all met.

20 For further explanation, the use of Bluetooth communication is met in paragraph [0043]. Part b) of the claim is met by the same rejection as claim 10a. Parts c) and d) are met by the same rejection as claim 10b. Part e) is met by the same rejection as claim 10c.

As per claim 25, the applicant discloses a first device according to claim 20, which is anticipated
25 by Odagiri (see above), with the following limitation which is also anticipated by Odagiri:

Wherein the Bluetooth-enabled mechanism is a Bluetooth-enabled radio ([0043]);

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The applicant should note that the specification defines a Bluetooth-enabled radio to be a two-way Bluetooth device. As discussed throughout the primary reference, both information processors (the wristwatch and the mobile phone) communicate with each other by transmitting and receiving messages to and from each other.

5

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Andrew Caldwell
Andrew Caldwell

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